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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------|-------------|----------------------|---------------------|------------------|
| 10/790,375 | 02/29/2004 | Mary K. Boncutter | 52052/MEG/R541 | 9358 |
| 23363 | 7590 | 12/20/2004 | EXAMINER | |
| CHRISTIE, PARKER & HALE, LLP | | | KAVANAUGH, JOHN T | |
| PO BOX 7068 | | | ART UNIT | |
| PASADENA, CA 91109-7068 | | | PAPER NUMBER | |
| | | | 3728 | |

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/790,375 | Applicant(s) BONCUTTER ET AL. | |
| | Examiner Ted Kavanaugh | Art Unit 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 11 and 14-33 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11-10-04 & 2-29-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 13 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper filed Nov. 8, 2004. Claims 1-9 were previously cancelled and therefore the restriction requirement is moot.
2. Applicant's election of species I (figures 1-6) in Paper filed Nov. 8, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 10,11,18-27,29-31 are rejected under 35 U.S.C. 102(a & e) as being anticipated by US 6021585 (Cole).

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Cole teaches a method of producing a footwear substantially as claimed including providing an outsole (14), an insole (12) having an inner structure of thermoplastic resin (see col. 4, lines 30-33; EVA is a thermoplastic resin), immersing the inner structure in vinyl polymer to form an outer coating that is a water barrier (see col. 5, lines 4-12 and col. 4 lines 11-29; polyvinyl chloride is a vinyl polymer and is inherently a water barrier). Regarding claim 23, the density of the EVA insole is a low density; see col. 4, lines 30-32. Regarding claim 32, inasmuch as the structure and the material is the same as applicants the footwear is naturally buoyant. Regarding claim 26, it is well known in the art that outsoles are wear resistant especially relative to the insole to prolong the life of the sole. Regarding claims 11, 30 and 31, see figure 3, which shows the indentations formed in the insole and therefore there is apertures provided in the inner structure. Regarding the apertures formed "before immersing the inner structure", Cole teaches the insole can be completely covered (see col. 5, line 8) and therefore the dipping process (immersing) would be performed after the apertures are formed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16,28,32 and 33 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cole '585.

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Cole teaches the method of producing footwear (see the rejection above) except for the thermoplastic resin contains plasticizer (claim 28) and rubber and PVC (claims 32-33). Regarding claim 16, Cole lacks the thermoplastic resin composition comprising NBR, polyvinyl chloride past resin, filler talc, foaming agent, plasticizer and process oil. Thermoplastic resin compositions typically contain various combinations of rubber, PVC, plasticizer and the other elements listed in claim 16 and therefore these feature are taught. To the extent that they are not, it would have been obvious to construct the inner structure of the insole of Cole with the thermoplastic resin comprising rubber, PVC and plasticizer, etc., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. Claim 14,15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole '585 in view of Official Notice.

Cole teaches a method as claimed except is silent with regard to if a color pigment was added to the composition forming the outer coating (i.e. the vinyl polymer coating). The examiner takes official notice that is it old and conventional in the art to add a color pigment to a composition to provide an attractive and aesthetic appearance. Therefore, it would have been obvious to provide the method of Cole with the step of adding a color pigment in forming the outer coating of the insole, to provide an attractive and aesthetic appearance. Regarding the selection of the color pigment in accordance with a color of the upper members, it would have been obvious to construct outer coating of the insole and the upper members as taught above with any appropriate

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change in appearance such as a designated color inasmuch as there is no functional relationship of the color of the footwear and the structure of the footwear. It would be an obvious design choice to construct the footwear with any desired color to provide a pleasing appearance to the wearer.

Allowable Subject Matter

9. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”


-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

Telephone inquiries regarding other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners" M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556.


Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
December 10, 2004